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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823

25559 7590 06/02/2005

ATMI, INC.
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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,038

Applicant(s)

RATH ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 23-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02 July 2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Papers filed on 27 April 2005.

I. Applicants' election with traverse of the invention of Group I, material claims 1-23 in the reply filed on 27 April 2005 is acknowledged. The traversal is on the ground(s) that the material claims and the method claims are not patentably independent and distinct. This is not found persuasive because the material claims have a different and distinct from the removing photoresist and/or sacrificial anti-reflect coating method claims as clearly set forth on the record. They also require a separate search as set forth on the record. Applicants request a rejoinder of the method claims when the material claims are allowable. It is possible.

The requirement is still deemed proper and is therefore made FINAL.

II. Applicants elect the species of the combination of "a quaternary ammonium base in combination with at least one of alkali and alkaline earth base" and its subspecies of formula "G" with traverse being acknowledged. The traversal is on the ground that the language "a strong base" in the non-elected species includes one of the quaternary ammonium and one or more alkali and alkali earth base of the elected species being acknowledged. Accordingly, there is no seriously burdensome search. This is not found persuasive because the non-elected species requires one base compound while the elected species requires multiple base compounds and the elected species does not require an oxidizing compound while the non-elected species requires an oxidizing compound. Therefore, an additional search for the additional non-elected species

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will be burdensome. Applicants request an extending search when the elected sub-species is found to be allowable. It is possible.

The requirement is still deemed proper and is therefore made FINAL.

III. The specification contains some errors. Please check and make corrections before an allowance is indicated. Please see at least claim 5 with two "fillers", "Formulation A" with "...methylnmorpholine...", "Formulation E" with "N(-3(C(-11...", "Formulation F" with "2-(2-diethylamino)ethoxy)ethanol" and "N(-3(-(C(-11...".

IV. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 5, 8-9, 11-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-17 of copending Application No. 10/389,214 as amended on 03 February 2005. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same or obviously chemical ingredients and the same or substantially the same amounts.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

V. It is a record that Application Serial No. 10/389,214 has its Publication No.

2004/0180300 being applied as followed:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 8-9 and 11- 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Minsek et al (2004/0180300).

Minsek et al disclose and teach a cleaning composition comprising a sufficient amount of a strong base, a sufficient amount of an oxidant, a sufficient amount of a chelator, a sufficient amount of a co-solvent, a sufficient amount of a surfactant and a sufficient amount of water.

Please see the whole disclosure of the applied reference, especially at paragraphs [0009], [0010], [0013], [0015], [0017]. [0018] to [0021], [0023] to [0025].

Since Minsek et al are reasonably disclose, teach and suggest the claimed embodiments, the above claims are found to be anticipated by Minsek et al.

VI. It is a record that Skee (6,599,370) is applied on the invention of Application Serial No. 10/389,214 has its Publication No. 2004/0180300.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 5, 8-9, 11-20 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Skee (6,599,370).

Skee discloses and teaches a cleaning composition comprising a sufficient amount of a strong base, a sufficient amount of an oxidant, a sufficient amount of a chelator, a sufficient amount of a co-solvent, a sufficient amount of a surfactant and a sufficient amount of water.

Please see the whole disclosure of the applied reference, especially at col.6:29-38, 44-50 and 54-59, 7:39, 9:1-20.

Since Skee is reasonably disclose, teach and suggest the claimed embodiments, the above claims are found to be anticipated by Skee.

VII. Applicants elect the species of the combination of “a quaternary ammonium base in combination with at least one of alkali and alkaline earth base” species and its subspecies of “Formulation G” in claims 1-7 and 10 as stated on the record by applicants have been considered and searched. Others non-elected species and subspecies have not been considered, searched or examined until all of the elected and applied species are overcome. Accordingly, claims 8-9 and 11-23 are withdrawn from consideration of a search as being non-elected species and subspecies.

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VIII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 with respect to the elected and applied species are rejected under 35

U.S.C. 102(b) as being anticipated by Carati et al (5,908,968).

Carati et al disclose and teach a clear alkaline aqueous composition comprising a sufficient amount of a quaternary ammonium base, a sufficient amount of an alkali metal salt base, an additive and a sufficient amount of water. Please see col.6:30-31. The intended use in the preamble with respect to “useful for...” has no value in the above applied statutory.

Since Carati et al is reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Carati et al.

IX. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5 and 10 with respect to the elected and applied species are rejected under 35

U.S.C. 102(a) as being anticipated by Miller et al (6,572,743).

Miller et al disclose and teach a clear alkaline aqueous composition comprising a sufficient amount of a quaternary ammonium base, a sufficient amount of potassium hydroxide,

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an additive and a sufficient amount of water. Please see col.13:8-16. The intended use in the preamble with respect to “useful for...” has no value in the above applied statutory.

Since Miller et al is reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Miller et al.

X. Claim 7 is depended on the rejected claim 1 and is objected to but it would be allowable if it is rewritten in an independent form.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
24 May 2005

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le